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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* ROBERT GIANNINI and
9 ROBERT J. CRAWFORD
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12 Appeal 2009-009186
13 Application 09/531,102
14 Technology Center 3600
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18 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R.
19 MOHANTY, *Administrative Patent Judges*.

20 FETTING, *Administrative Patent Judge*.

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DECISION ON REQUEST FOR REHEARING

STATEMENT OF CASE

This is a decision on rehearing in Appeal No. 2009-00009186. We have jurisdiction under 35 U.S.C. § 6(b).

Requests for Rehearing are limited to matters misapprehended or overlooked by the Board in rendering the original decision. 37 C.F.R. § 41.52.

ISSUES ON REHEARING

Appellants raise 3 issues in the Request for Rehearing. The first issue relates to whether the panel misconstrued the term “compatible.” The second issue relates to whether the panel erroneously found the rationale for modification of the art to be legally sufficient. The third issue relates to whether the panel introduced a new ground of rejection.

ANALYSIS

As to the issue regarding the term “compatible” as applied to two colors in claims 25 and 26, the panel found the term to be of subjective rather than objective determination similar to the term aesthetically pleasing in *Datamize LLC v Plumtree Software, Inc.* 417 F.3d, 1342, 1350 (Fed. Cir. 2005). The Appellants contend such a wide scope is not within the spirit of the invention and is not defined by the claims. Request 4.

We agree the term is not defined anywhere in the claims or Specification, and we find the Specification nowhere circumscribes the spirit of the invention. Hence the necessity of ascertaining what the term meant. The Appellants take issue with the dictionary definitions of the term, but the Appellants used the term and must accept its implications. While it may be that some of the dictionary definitions are inapplicable, clearly the definition

of in agreement with as applied to colors, meaning that colors agree with one another, is applicable, and its application is in the eye of the beholder.

As to the issue of the combinability of the references, the Appellants argue that the Examiner's rationale of color matching was legally insufficient. Request 5. The Examiner pointed to specific portion of the art by column and line number to support this rationale. The Appellants contend the Examiner's finding is conclusory. The Examiner's reasoned that one of ordinary skill would find it predictable and useful to have a way of minimizing the differences between colors. We fail to see how this is conclusory as the finding sets forth the specific facts for the reasoning, *viz.*, colors are matched and minimizing color differences in such matching is desirable.

The Appellants then appear to turn *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) on its head by arguing that a finding of obviousness is the predicate to finding predictability. Request 6. This is incorrect. The reverse is the holding of *KSR*. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* 550 U.S. at 416.

Next the Appellants invite the panel to declare the obviousness rejections as new grounds. We decline the invitation. The Appellants contend that the panel made a finding of an input that was not introduced into the prosecution record beforehand. Request 7. The panel was responding to the Appellants' argument that the Examiner failed to provide an explanation of how CMY output from one device and input to the next device correspond to the claims in the Examiner's explanation of the reasoning for combining the references. This argument did not contend that

one of the limitations was not described. The panel simply found this contention to be irrelevant. The Examiner made no findings as to the specific nature of the signal used as this was unnecessary. It was the Appellants who raised this issue and the panel merely responded to the issue raised by the Appellants. The Board cannot be said to have presented a new ground of rejection simply by elaborating on the examiner's rejection or by using different words. *See In re Oetiker*, 977 F.2d 1443, 1445-46 (Fed. Cir. 1992).

CONCLUSION

Nothing in Appellants' request have convinced us that we have overlooked or misapprehended the claims and applied art, and failed to recognize a new ground of rejection as argued by Appellants. Accordingly, we leave the Decision in place.

DECISION

To summarize, our decision is as follows:

- We have considered the REQUEST FOR REHEARING
- We DENY the request that we reverse the Examiner as to claims 17-31.

REHEARING DENIED

MP